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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re U.S. Patent 6,470,844

CERTIFICATE OF CORRECTION BRANCH

BIESS et al.

Issued: October 29, 2002

Serial No.: 09/773,072

Group Art Unit: 3747

Filed: January 31, 2001

Examiner: H. Ali

Title: SYSTEM AND METHOD FOR SUPPLYING AUXILIARY POWER TO A LARGE DIESEL ENGINE

* * * * *

May 6, 2003

STATUS INQUIRY

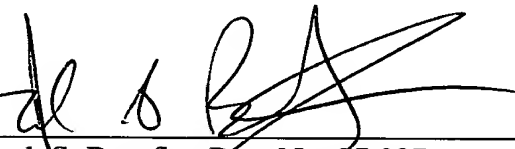
Honorable Commissioner of
Patents and Trademarks
Alexandria, VA 22313

Sir:

A Request for Certificate of Correction for the above-identified patent was filed on November 15, 2002. To date, we have not received a notice accepting the Certificate. The Certificate was filed in order to reflect the inventors of the patent as Lawrence J. Biess and Christer Gotmalm.

It is respectfully requested that a notification of the status of this Certificate of Correction be sent to the undersigned attorney of record.

Respectfully submitted,
PILLSBURY WINTHROP LLP

By: 

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Changes to the Patent Rules

October 20, 2000

Volume 1, Issue 3

This is the third in a series of Patent News Bulletins to assist you in keeping up to date with significant rule changes which affect your are. Keep this copy to use as a bookmark for your present MPEP, or view this bulletin again on the USPTO Website.



Simplified Amendment Practice. Replacement paragraphs/sections/claims to be used. 37 CFR 1.121

The rule package "Changes to the Patent Business Goals - Final Rule," published in the Federal Register on September 8, 2000, 65 Fed. Reg. 54603 (Sept. 8, 2000), and the Official Gazette on September 19, 2000, 1238 Off. Gaz. Pat. Office 77 (September 19, 2000). The PBG rule package makes a number of revisions to Title 37.

The entire final rule may be found at the USPTO Website at <http://www.uspto.gov/web/offices/dcom/olia/pbg/Index.html>.

Areas and individuals primarily affected by this rule change include:
(1) Patent Examiners and Tech Support Staff in the Technology Centers
(2) Office of Patent Publication

Any questions related to this change in practice should be directed to Joe Narcavage, Special Projects Exr., (703-305-1795) or Lt. Dougherty, Legal Advisor, (703-306-3156) OPLA.

Mandatory compliance with the revised rule is not required until March 1, 2001. It is suggested that applicants adopt the revised procedures on or after November 7, 2000, in order to adjust to the changes in amendment practice.

Under the new amendment practice, amendments to the specification must be made by the submission of clean new or replacement paragraph(s), section(s), specification, or claim(s). This practice will provide a specification (including claims) in clean, or substantially clean, form that can be effectively captured and converted by optical character recognition (OCR) scanning during the patent printing process.

The new practice requires applicant to provide, in addition to the clean version of a replacement paragraph/section/claim, a marked-up version using applicant's choice of a conventional marking system to indicate the changes, which will aid the examiner in identifying the changes that have been made. The marked-up version must be based on the previous version and indicate (by markings) how the previous version has been modified to produce the clean version submitted in the current amendment. The term "previous version" means the version of record in the application as originally filed or from a previously entered amendment.

The following format is suggested in an amendment paper: (1) a clean version of each replacement paragraph/section/claim with clear instructions for entry; (2) starting on a separate page, any remarks/arguments (37 CFR 1.111); and (3) starting on a separate page, a marked-up

version entitled "Version with markings to show changes made."

Applicants will also be able to submit a clean set of all pending claims, consolidating all previous versions of pending claims from a series of separate amendments into a single clean version in a single amendment paper. This submission of a clean version of all of the pending claims will be construed as directing the cancellation of all previous versions of any pending claims. No marked-up version will be required to accompany the clean version where no changes other than the consolidation are being made.

*Amendment by
paragraph/claim
replacement in clean form.*

The amended rule encourages issuance of applications with an examiner's amendment without practitioners/applicants having to file a formal amendment. Additions or deletions of subject matter in the specification, including the claims, may continue to be

made in an examiner's amendment at the time of allowance by instructions to make any change at a precise location in the specification or the claims. An examiner's amendment may incorporate a printed copy of a fax or e-mail amendment submitted by applicant. Only that part of the e-mail or fax directed to a clean version, or a portion of, a paragraph/claim to be added should be printed and attached to the examiner's amendment, with a paper copy of the entire e-mail or fax being entered in the file. The electronic version of the e-mail is not required to be saved once the printed e-mail (and any attachments) become part of the application file record.

MPEP 714+ & 1302.04



PATENT ASSIGNMENT AGREEMENT

THIS PATENT ASSIGNMENT AGREEMENT ("Agreement") is made as of the Effective Date by and between Christer Gotmalm ("Assignor"), an individual residing in Canada and CSXT Intellectual Properties Corporation ("CSXTIP" or "Assignee"), a Delaware corporation and wholly owned subsidiary of CSX Transportation, Inc. ("CSXT"), with offices located at 500 Water Street, Jacksonville, Florida 32202, United States of America.

WITNESSETH:

WHEREAS, Assignor was engaged by Assignee's parent company to invent certain new and useful processes, machines, articles of manufacture, and/or improvements thereof pertaining to auxiliary power units and ancillary devices for use with locomotive diesel engines disclosed in United States and Canadian Applications for Letters Patent entitled *System and Method for Supplying Auxiliary Power to a Large Diesel Engine, Locomotive Data Management System and Method Based on Monitored Location and Locomotive Emission Reduction Kit and Method of Earning Emission Credits*, U.S. Application Nos. 09/773,072, 09/845564, 09/845565 filed in January 2001 and Canadian No. 2,363,582 filed November 19, 2001 ("Applications"), and as continue to be refined and developed ("Invention"); and

WHEREAS, Assignor is a shareholder of the Canadian corporation that owns International Road & Rail (U.S.), which has formed a limited liability company jointly with Assignee affiliate CSXT Environmental Corporation, called EcoTrans Technologies, LLC ("EcoTrans") for the production and marketing of the Invention; and

WHEREAS, in connection with Assignor's investment in ECOTRANS and based upon the foregoing, Assignee desired to acquire and Assignor has conveyed and desires to convey to Assignee all rights, title and interests in and to the Invention and the related Patent Applications through a series of Assignments dated August 8, 2001 and this Assignment; and

WHEREAS, the Parties wish to confirm the intent expressed in earlier assignments that all developments pertaining to the Invention are within their scope;

NOW, THEREFORE, for good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, Assignee and Assignor hereby agree as follows:

TERMS AND CONDITIONS

Section 1 - Recitals: The above identification of parties and recitals is true and correct and the definitions are incorporated into this Assignment.

Section 2 - Assignment: Assignor hereby conveys, assigns and transfers to Assignee all rights, title and interests in and to the Invention, the associated technology and know-how, the Applications, all divisions, substitutions, continuations and continuations-in-part thereof, and all Canadian and United States Letters Patent which may be granted thereon and all reissues and extensions thereof, and all priority rights under the International Convention for the Protection of Industrial Property for every member country, and all applications for patents (including, without limitation, related rights such as utility-model registrations and inventor's certificates) heretofore or hereafter filed for the Invention in any foreign countries, including the right to apply for patents in any foreign countries in Assignee's name, and all patents (including all extensions, renewals and reissues thereof) granted for the Invention in any foreign countries.

Section 3 - Issuance: Assignor hereby authorizes and requests the Canadian Intellectual Property Office and the United States Commissioner of Patents to issue all Canadian and United States Letters Patent on the Applications and/or respecting the Invention to Assignee (or its designated subsidiary or affiliate), as the assignee of all rights, title and interests in and to the Applications and the Invention. Assignor hereby authorizes and requests that any officials of foreign countries whose duty it is to issue patents, issue all patents respecting the Invention to CSXT Intellectual Property, Inc. or its designated subsidiary or affiliate, as the assignee of all rights, title and interests in and to the same.

Section 4 - Warranty of Title: Assignor represents and warrants that Assignor has full right to convey the rights, title and interests herein assigned, that Assignor has not and will not execute any agreement in conflict herewith, and that the rights, title and interests assigned herein are not encumbered by any grant, license or right heretofore given to another party.

Section 5 - No other Warranty: The Assignee accepts this assignment "as is" and without any representation or warranty, express or implied, including without limitation any implied warranty of merchantability or fitness for any particular purpose, any warranty arising from course of performance, course of dealing or usage of trade, regarding the patentability of the Invention or the enforceability of any patents issuing thereupon, if any, or any warranty that the use of the information or materials will not infringe or violate any patent or other intellectual property rights of any third party.

Section 6 - Indemnification of Assignor: Assignee agrees to indemnify and hold Assignor and its successors and assigns, harmless against any liability, damage or expense (including costs and attorneys' fees and expenses) by reason or arising out of or relating to any act, duties or obligations or omissions of the Assignee or of any personnel employed or otherwise engaged by the Assignee, howsoever arising and that Assignee shall, at the request of the Assignor, assume the defense of any demand, claim, action, suit or proceeding brought against the Assignor in any way connected to the Invention or the Applications or any enhancements hereafter thereto and pay any and all damages assessed against or that are payable by the Assignor as a result of disposition of any such demand, claim, action, suit or proceeding. Notwithstanding the foregoing, the Assignor may be represented at any such action suit or proceeding at its own expense and by its own legal counsel.

Section 7 - No Contest: Assignor shall not contest or aid in contesting the validity or Assignee's ownership of the copyrights, trade secrets and patents (including, without limitation, any and all patents which issue on the Applications and/or respecting the Invention) of Assignee.

Section 8 - Cooperation: Assignor shall promptly provide all assistance, cooperation, and information reasonably necessary for Assignee to prepare, complete, prosecute, maintain, preserve, enforce and/or defend the Applications and/or any patent respecting the Invention without further consideration. Such assistance and cooperation shall include, without limitation, making all rightful oaths regarding the Invention or Applications and executing and delivering any written instruments respecting the Invention or Applications, including but not limited to affidavits and powers of attorney.

Section 9 - Confidentiality: Assignor shall preserve the secrecy of the Applications, the contents therein,

and the Invention and all developments, unless and until the Canadian Intellectual Property Office and the United States Commissioner of Patents and Trademarks issue Patent on the Applications and/or respecting the Invention.

Section 10 - Governing Law: This Agreement shall be governed by the laws of the United States of America and the State of Florida with the exception of conflicting conflicts of law provisions and venue shall be Duval County, Florida.

Section 11 - Arbitration: Any matter, controversy, claim or dispute arising hereunder or in connection herewith shall be submitted to binding arbitration before three neutral arbitrators pursuant to the terms and provisions of this Section.

(a) Rules and Selection of Arbitrators. Arbitration of disputes under this Agreement shall be conducted under the arbitration Rules of the American Arbitration Association ("AAA") then applicable (provided that in the event of any conflict between such rules and this Section, the terms of this Section shall control). Within 30 days of the service of a notice of request to arbitrate, each of ASSIGNEE and ASSIGNOR will appoint one arbitrator which will be chosen from a list of qualified arbitrators provided by the AAA, and such arbitrators shall appoint a third arbitrator. The arbitrators appointed must be attorneys with at least fifteen (15) years of experience with contract-related issues. In no event shall the demand for arbitration be made after the date when institution of legal or equitable proceedings based on the dispute in question would be barred by applicable statute of limitations.

(b) Powers of Arbitrators. The arbitrator shall have the power to grant all appropriate legal and equitable relief (both by way of interim relief and as part of its final award) other than punitive damages, as may be granted by any court of the U.S., to carry out the terms of this Agreement (e.g., declaratory and injunctive relief and damages). ASSIGNEE and ASSIGNOR expressly waive any right to punitive damages arising out of any dispute under this Agreement. The arbitrator shall be required to follow the terms and provisions of this Agreement and the law then applicable to the dispute. All awards and orders of the arbitrator (including, but not limited to, interim relief) shall be final and binding on the parties. Unless the parties mutually agree otherwise, if arbitration is commenced by ASSIGNOR, it shall take place in Jacksonville,

Florida, and if arbitration is commenced by ASSIGNEE, it shall take place in London, Ontario, Canada.

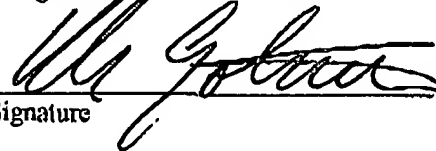
(c) Discovery and Rules of Evidence. It is the intention of the parties that all arbitration proceedings be conducted as expeditiously as reasonably possible in keeping with fairness and with the minimum of legal formalities. Therefore, ASSIGNEE and ASSIGNOR have agreed that the rules of evidence shall not apply to any arbitration proceeding, except that, notwithstanding the foregoing, the attorney-client privilege and work product protection shall be applicable in all arbitration proceedings. ASSIGNEE and ASSIGNOR agree that only limited discovery shall be allowed in any arbitration proceeding. In addition, the parties shall exchange the names, qualification and a narrative report stating the opinion and basis therefore of any expert intended to be used as a witness twenty (20) days prior to the start of the arbitration.

(d) Costs of Arbitration. Costs and fees of the arbitrator and of the AAA shall be borne equally by ASSIGNEE and ASSIGNOR. Each party shall bear its own attorney's fees, and expert and non-expert witness costs and expenses, in connection with the arbitration proceeding.

Section 12 - Effective Date: The term "Effective Date" shall mean January 31, 2002.

IN WITNESS WHEREOF, this Agreement has been executed as of the Effective Date.

Assignor: Christer Gotmalm


Signature

Nov 13 - 2002
Date

Before me personally appeared Assignor, known to me or proved to me on the basis of satisfactory evidence to be the person whose name is subscribed to this Agreement, and acknowledged that he/she executed the same.


Notary Public

Assignee: CSXT Intellectual Properties Corp.

Signature

By:

Title

Date

Before me personally appeared the individual signing on behalf of Assignee, known to me or proved to me on the basis of satisfactory evidence to be the person who represents the Assignee subscribed to in this Agreement, and acknowledged that he/she executed the same.

Notary Public